

REMARKS

Claims 1-26 are pending in the application. Claims 8-14 have been withdrawn pursuant to a restriction requirement. Hence, claims 1-7 and 15-26 are all the claims under consideration.

Claim Rejections - 35 U.S.C. § 103

Claims 6, 18, and 27

Claims 6, 18 and 27 are rejected under § 103(a) over Potsch et al. (U.S. 3,788,180, hereinafter “Potsch”) in view of Wakayama et al. (U.S. 5,836,229, hereinafter “Wakayama”). The Examiner asserts that the combination of Potsch and Wakayama teaches substantially all of the claim features. The Examiner concedes that neither reference discloses “the specifics with regard to the irregularities” (See Office Action page 3), but takes Official Notice that “it would have been obvious to try/experiment with the different shapes/sizes to determine which type of irregularities work best with specific work pieces.” Applicants respectfully traverse.

Applicants submit that the Examiner has given insufficient reason to combine Potsch and Wakayama. The Examiner asserts that one having ordinary skill in the art would have found it obvious to combine Potsch and Wakayama “to prevent blade slippage.”

Applicants submit that, contrary to the Examiner’s assertion, combining these two references would not be obvious to one having ordinary skill in the art, and the combination would not yield the present invention. Wakayama discloses an apparatus for scribing a line onto a glass plate, so that the glass may then be broken at a particular location. See col. 1, line 15-17. It does not teach cutting the glass itself. Further, Wakayama teaches that the use of protrusions and grooves in the blade are well-known in the art “to minimize any possible slip of the cutting

disc relative to the plate glass" (see col. 1 line 38-39). Notably, the slippage it is concerned with is horizontal slippage, i.e. the movement of the plate glass relative to the cutting blade. In contrast, the present invention is concerned with vertical slippage, i.e. the movement of two cut pieces of material relative to one another. As illustrated in Figs. 6 and 7 of the present application, the present application focuses on minimizing flaws caused by cutting the material.

As Potsch cuts material such as leather, plastic, paper, cardboard, or metal (see col. 5, line 18-23) and does not scribe lines for later breaking, it is similarly not concerned with the horizontal slippage found in Wakayama. Rather, the use of protrusions and grooves in Wakayama designed to prevent horizontal slippage on a hard surface would likely damage the materials cut by Potsch. Therefore, Applicants submit that it would not have been obvious to incorporate the features of Wakayama into Potsch as taught by the Examiner, as the protrusions and grooves of Wakayama are addressed towards a problem that the Potsch invention does not have.

Regarding the Official Notice, the Examiner has offered no reason why a person having ordinary skill in the art would have found it obvious to experiment with different irregularities. The Examiner only makes a conclusory statement that "there are a limited number of choices available to a person of ordinary skill in the art with regards to the size of the irregularity quantity, the shape, and the periodicity on a rotary blade" (see Office Action, page 3). Applicants submit that this is improper.

For these reasons, Applicants submit that claim 6 should be patentable over the cited art, and request that the rejection of this claim be withdrawn. Applicants further submit that claims 18 and 21 are patentable at least by virtue of their dependencies from claim 6.

Claims 21-23

Claims 21-23 are rejected under § 103(a) over Potsch in view of Wakayama and further in view of Wingen (U.S. 4,275,631). The Examiner asserts that Potsch and Wakayama teach substantially all of the claim features, except for a “drum-shaped rotary blade comprising a plurality of grooves.” The Examiner asserts that Wingen cures this deficiency, and concludes that the combination of references renders the claims obvious, “because all claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective function and the combination would have yielded predictable results.” Applicants respectfully traverse.

Applicants submit that the Examiner has not provided sufficient reason to combine these references. The mere fact that the claimed features may be found in the prior art and that the combination of elements may lead to allegedly “predictable” results is not enough without some reason to combine the references¹. Therefore, for similar reasons as above, the rejection is improper.

¹ *KSR v. Teleflex*, 127 S. Ct. 1727, 1741 (2007)

Applicants further submit that Wingen does not cure the above-noted deficiencies of Potsch and Wakayama. Applicants therefore submit that claims 21-23 are patentable over the cited art least by virtue of their dependency from claim 6.

Allowable Subject Matter

Applicants thank the Examiner for allowing claims 1-5, 7, 15-17, 19, 20, and 24-26.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

/SMG/

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